

PATENT APPLICATION
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of

Docket No: A8063

Timothy A. BEST, et al.

Appln. No.: 09/747,063

Group Art Unit: 2173

Confirmation No.: 1655

Examiner: Namitha PILLAI

Filed: December 22, 2000

For: WEBTOP: MULTIPLE APPLLET DELIVERY WITHIN A FIXED-SIZED VIEWING
SPACE

REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.41

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In accordance with the provisions of 37 C.F.R. § 41.41, Appellant respectfully submits this Reply Brief in response to the Examiner's Answer dated March 4, 2008. This Reply Brief is timely filed as May 4, 2008 is a Sunday. Entry of this Reply Brief is respectfully requested.

Table of Contents

STATUS OF CLAIMS.....	2
GROUND OF REJECTION TO BE REVIEWED ON APPEAL.....	3
ARGUMENT.....	4
CONCLUSION.....	15

REPLY BRIEF UNDER 37 C.F.R. § 41.41
U.S. Appln. No.: 09/747,063

STATUS OF CLAIMS

Claims 1-42, 46-48, 51, 52, and 54-60 are all the claims pending in the application.

Claims 43-45, 49, 50, and 53 have been previously canceled.

Only claim 52 now stands rejected under 35 U.S.C. § 112, first paragraph. From the Examiner's Answer, it appears that the Examiner withdrew the rejection under 35 U.S.C. § 112, first paragraph of claims 57-60.

Claims 1-42, 46-48, 51, 52, and 54-60 remain rejected under 35 U.S.C. § 103(a).

These rejections of claims 1-42, 46-48, 51, 52, and 54-60 are being appealed.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

There are four issues on Appeal.

The first issue is whether claim 52 is improperly finally rejected under 35 U.S.C. § 112, first paragraph.¹

The second issue is whether claims 1-4, 9-12, 14-18, 23-26, 28-32, 37-40, 42, 46-48, 51-52, 54-58, and 60 are improperly finally rejected under 35 U.S.C. § 103(a) as being unpatentable over WO 98/43170 to Banthia (hereinafter “Banthia”).

The third issue is whether claims 5-8, 19-22, 33-36, and 59 are improperly finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Banthia in view of U.S. Patent No. 5,561,757 to Southgate (hereinafter “Southgate”).

The fourth issue is whether claims 13, 27, and 41 are improperly finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Banthia in view of “The Swing Tool Set” article (hereinafter “STS”).

¹ Based on the Examiner’s Answer, it appears that the rejection under 35 U.S.C. § 112, first paragraph of claims 57-60 has been withdrawn (*see* page 3 of the Examiner’s Answer).

ARGUMENT

Appellant respectfully requests the Board to reverse these grounds of rejection at least for the reasons set forth in the Amended Appeal Brief filed on December 13, 2007 (hereinafter “Appeal Brief”). Furthermore, although Appellant believes that the Appeal Brief adequately addresses the Examiner’s position, Appellant provides additional remarks that address specific points raised in the Examiner’s Answer mailed March 4, 2008 (hereinafter “Examiner’s Answer”), herein below.

Issue 1: Claim Rejection under 35 U.S.C. § 112

Claim 52 is rejected under 35 U.S.C. § 112, first paragraph. With respect to claim 52, the Examiner maintains that the specification does not disclose or suggest “at least two of said plurality of applets do not inherit functions from same base class.” Specifically, the Examiner maintains that the two applets can carry out different functionality and yet have basic characteristics in common such that they inherit from the same base class. Accordingly, the Examiner concludes that one of ordinary skill in the art would not know that two applets can inherit from different base classes (*see* pages 11-12 of the Examiner’s Answer).

Appellant respectfully notes that when two applets carry out different types of functionalities, they would belong to different JAVA base classes. That is, one of ordinary skill in the art familiar with JAVA would readily recognize in light of the specification that applets with different functionalities do not necessarily inherit from the same base class at least in view of specific exemplary embodiments of the present invention.

For example, the specification discloses encoding applet “sevenAMNewsTicker.class” and encoding applet “MyApplet.class” to be embedded in a web page (*see* page 7, line 20 to page 8, line 26 of the specification). These exemplary applets are independent and do not inherit features from the same base class. The Examiner has not shown or explained why one of ordinary skill in the art would not understand that these different applets (that are brought from various databases via “Portal” web page) inherit from different base classes. In fact, the Examiner has not put forth any reasoning why one of ordinary skill in the art would believe that these different types of applets obtained from various databases would necessarily inherit features from all the same base classes. In fact, the Examiner’s position advanced with respect to this rejection is inconsistent with the Examiner’s position of Banthia with respect to the § 103 rejection of this claim (the Examiner incorrectly infers different base classes from the displayed applets in Banthia).

Moreover, an exemplary embodiment of the present invention further discloses applets “Did You Know?” “Corporate News” and “Business Intelligence” (*see* page 11, line 15 to page 12, line 9 of the specification). These applets, as their names suggest, are independent applets that belong to at least one different base class. That is, these applets would inherit from at least one different base class (*e.g.*, news information type applet and *e.g.*, business information type applet). In fact, when applets implementing different types of functions, they would need to inherit from different JAVA base classes. In other words, the specification discloses a “Portal” that brings together various applets, these different applets will have at least one different base class.

As another example, one of ordinary skill in the art would readily understand that the “Portal” website allows for a loan calculator applet and a word processor applet to be loaded. The loan calculator applet would inherit functions from a calculator base class and the word processor applet would inherit functions from a text rendering base class.

Appellant respectfully maintains that the disclosure of various independent applets being loaded from various databases to a “Portal” webpage along with various examples provided in the specification would apprise and readily suggest to a person having ordinary skill in the art that at least two of the independent applets do not inherit functions from the same base class.

Accordingly, Appellant respectfully submits that “at least two of the plurality of applets do not inherit functions from the same base class” is adequately described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Appellant respectfully requests the Board to reverse this rejection of claim 52 under 35 U.S.C. § 112, first paragraph.

Issue 2: Rejection in view of Banthia

Claims 1-4, 9-12, 14-18, 23-26, 28-32, 37-40, 42, 46-48, 51-58, and 60 are rejected under 35 U.S.C. § 103(a) as being unpatentable over WO 98/43170 to Banthia (hereinafter “Banthia”). Appellant respectfully requests the Board to reverse these grounds of rejection at least in view of the following additional comments.

1) Claims 1, 15 and 29

Claims 1, 15, and 29 each contain the feature of “wherein each selected applet is displayed in the separate window inside the displayed main applet.” That is, the present

invention relates to displaying applets within applet. The specification discloses that applets are “small programs which can be ‘embedded’ into Web pages...[applets] are designed to be executed from within other applications” (*see* page 3, lines 8 to 13 of the specification). These applets are interpreted by Java Virtual Machines and have their own advantages and limitations.

Although the Examiner did not find any reference that would remotely suggest displaying applets within applet, the Examiner alleges that Banthia suggests these unique features of the independent claims in view of a) its disclosure of displaying applets within a browser window and b) its disclosure of having a control applet which hypothetically could be displayed (*see* pages 12-13 of the Office Action).

However, the control applet of Banthia is a communication applet that communicates data from the server to the displayed applets (*see* Abstract). In other words, the control applet of Banthia is a server/service applet and as such Banthia discloses that this applet is hidden. The Examiner acknowledges that Banthia explicitly discloses that the control applet is hidden but alleges that the parameters of the control applet can be changed such that it will be displayed allegedly because Banthia discloses the display size of the control applet is set to zero (*see* page 12 of the Office Action). Appellant respectfully notes that this position is technically inaccurate because the server/service applets are applets that execute some internal functionality *e.g.*, communicate with the server and are not displayed *i.e.*, display size set to zero.

Furthermore, Appellant respectfully notes that even if this applet was somehow displayed, there is still no disclosure or suggestion that other applets would be executed and displayed within this control applet. In other words, the control applet of Banthia does not and

cannot suggest displaying and executing applets within applet. Similar to the conventional techniques, Banthia only discloses displaying an applet within a browser window and not displaying applets within applet.

Appellant respectfully maintains that Banthia **teaches away** from displaying the separate applet windows within a main applet or any other applet (displaying applets within applet) because Banthia provides an alternate method of organizing the display of the separate applet windows by providing a method for “tearing off” a separate applet window from the main browser window and displaying the torn off applet in a separate browser window, allowing a user to reposition the torn off browser windows in order to resize or reposition the separate applet windows (page 4, lines 3-17). This argument remains unrebutted by the Examiner and is not addressed in the Examiner’s Answer (*see* pages 12-13 of the Examiner’s Answer). In short, Banthia does not disclose or even remotely suggest displaying applets within applet.

For at least these exemplary reasons and the exemplary reasons set forth in the amended Appeal Brief filed December 13, 2007, independent claims 1, 15, 29, 46, and 57 are patentable over Banthia. Accordingly, Appellant respectfully requests the Board to reverse this rejection of independent claims 1, 15, 29, 46, and 57, and the other rejected claims which depend therefrom.

2) Additional Arguments for Independent Claim 57

Furthermore, independent claim 57 recites: “dynamically selecting a plurality of applets from a displayed list of the plurality of available applets that are displayed in the displayed main applet, where the plurality of applets displayed in the list are not yet loaded for execution.” The Examiner alleges that the six applets displayed in a browser window as depicted in Fig. 5 of

Banthia meet the unique features quoted above because each applet is executed and displayed together with its name and because new data is provided to the applets prior to reloading, which allegedly means that the applet is not yet loaded (*see* page 13 of the Examiner's Answer).

Appellant respectfully submits, however, that Banthia fails to disclose or suggest displaying a list of the unloaded available applets *i.e.*, a list of available applets prior to the applets being loaded. That is, Banthia only discloses providing the name of the applet during its execution (Fig. 5). In other words, even if the applet being executed may be updated with the new data that does not mean that the applet is not yet loaded. In fact, as is clearly disclosed in Banthia (Fig. 5 and page 7), the loaded applet is being executed when it is updated with new information (refreshed).

Furthermore, if the Examiner alleges that the applets are not yet loaded because the data has not been modified yet, then the name of the applets displayed in Fig. 5 of Banthia is the name of the applet being executed and not the name of the allegedly unloaded applet. Although Banthia discloses updating the executed applet with new information (page 7, lines 7 to 10), the applets are clearly loaded, displayed, and are updated during execution. Appellant respectfully maintained that Banthia does not disclose or suggest providing a list of available applets not yet loaded for execution. In addition, Appellant respectfully submits that Fig. 5 of Banthia discloses displaying the actual applets and not a list of available applets that are not yet loaded for execution.

For at least these additional exemplary reasons, independent claim 57 is patentable over Banthia.

3) *Additional Arguments for Dependent Claims*

Dependent claim 11 recites: “loading the main applet into a Java application, wherein the main applet is a webtop applet.” The Examiner alleges that since Banthia discloses loading applets onto a Java enabled web browser, Banthia discloses a webtop applet (*see* page 14 of the Examiner’s Answer). Appellant respectfully maintains that Banthia fails to even remotely suggest displaying applets within an applet. Banthia’s browser is JAVA enabled so that it can display applets. If Banthia’s browser was not JAVA enabled, it could not display any applets. However, as explained above, having a browser that can display applets does not follow that the browser is an applet *i.e.*, webtop applet. A browser is not executed from another application and is not interpreted by the JAVA virtual machine. In short, a browser is not and cannot be an applet. For at least these additional exemplary reasons, claim 11 is patentable over Banthia.

Dependent claim 12 further recites: “executing the main applet to display, within the displayed main applet, a list of available applets from which users can select applets.” The Examiner neglects to address the features of executing a main applet and displaying within the displayed main applet a list of available applets (*see* page 14 of the Examiner’s Answer). The Examiner further fails to provide the supporting passages in Banthia (*see* page 14 of the Examiner’s Answer). Appellant respectfully maintains that the Examiner’s position amounts to a speculation and is not substantiated by the actual disclosure of Banthia. As explained above, Banthia does not disclose or suggest displaying applets within applet. Appellant further notes that Fig. 5 of Banthia does not disclose or even remotely suggest displaying a list of applets. For at least these additional exemplary reasons, claim 12 is patentable over Banthia.

Dependent claim 52 recites: “said plurality of applets are independent of each other and at least two of said plurality of applets do not inherit functions from same base class.” The Examiner alleges that Banthia discloses that each applet inherits from a different base class (*see* page 14 of the Examiner’s Answer). However, the Examiner simply relies on the figures of Banthia, which clearly do not disclose or suggest these features of claim 52. The Examiner cannot provide any passages in the specification of Banthia that would allegedly suggest these unique features of claim 52. This position is inconsistent with the Examiner’s position advanced with respect to the rejection under 35 U.S.C. § 112, first paragraph.

Furthermore, the Examiner’s position amounts to a mere speculation not substantiated by the Banthia reference and in fact is technically inaccurate in view of the Banthia’s explicit disclosure. Banthia discloses that the display applets inherit from the same base class (*see* page 7, lines 24 to 34 of Banthia). Furthermore, in Banthia, same model is displayed in multiple views (applets) *i.e.*, one applet is provided for each view of the same information (Fig. 5). That is, in Banthia, the displayed applets are interdependent. The displayed applets all depend from the same base class *i.e.*, inherit features of the same base class (Fig. 3; page 7, lines 24 to 34 of Banthia). In short, Banthia fails to suggest displaying **any type** of applets *i.e.*, applets that do not inherit functions from the same base class. For at least this additional exemplary reason, claim 52 is patentable over Banthia.

Dependent claim 54 recites: “wherein the receiving comprises receiving at substantially the same time the user selection of the plurality of applets.” The Examiner alleges that since the

user can tear off the displayed applet (Fig. 5 of Banthia), Banthia discloses these unique features of claim 54 (*see* pages 13-14 of the Examiner's Answer).

Appellant respectfully notes that Banthia disclose moving an applet or tearing off an applet (page 8, lines 25 to 35 of Banthia) and not receiving user selection of **plurality of applets** at substantially same time. That is, Banthia clearly fails to disclose or even remotely suggest that the system will receive user selection of a plurality of applets at substantially same time. On the contrary, in Banthia, the user will select a first applet for tear off and the system will implement the tear off process, the user will then select a second applet for tear off and the system will then implement the tear off process for this second applet. In other words, the tear off process is sequentially implemented, one by one, and Banthia fails to disclose or even remotely suggest receiving user selection of a plurality of applets at substantially same time. For at least this additional exemplary reason, claim 54 is patentable over Banthia.

Dependent claim 60 recites: "at least two applets of said applets are obtained from different computers and are displayed in a respective window inside the displayed main applet at same time." The Examiner alleges that since Banthia discloses internet, Banthia discloses the above-noted unique features of claim 60 (*see* page 15 of the Examiner's Answer). Appellant respectfully notes that this position disregards the technical teachings of Banthia.

Specifically, Banthia discloses all applets are displayed and the communication with the server is optimized by having **one communication applet (the controlling applet)** handling the communication for all these applets (page 6 of Banthia). In other words, all applets being displayed are handled **via one communication threat** and accordingly, is obtained from same

place (page 7, lines 7 to 18 of Banthia). That is, if only one controlling applet is used (that provides the communication threat) as disclosed in Banthia, the applets **must be obtained from the same place**. That is, Banthia does not disclose or suggest **displaying two applets from different locations at same time**.

For at least this additional exemplary reason, claim 60 is patentable over Banthia.

Issue 3: Rejection in view of Banthia and Southgate

Claims 5-8, 19-22, 33-36, and 59 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Banthia in view of U.S. Patent No. 5,561,757 to Southgate (hereinafter “Southgate”). Appellant respectfully requests the Board to reverse these grounds of rejection at least in view of the arguments set forth in the Appeal Brief.

Issue 4: Rejection in view of Banthia and STS

Claims 13, 27, and 41 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Banthia and “The Swing Tool Set” article (hereinafter “STS”). Appellant respectfully requests the Board to reverse these grounds of rejection at least in view of the following additional comments.

It is respectfully submitted that the STS reference fails to cure the deficiencies of Banthia discussed above for claims 1, 15, and 29, and accordingly, claims 13, 27, and 41 are patentable over the asserted combination of Banthia and the STS reference at least by virtue of their dependency from the independent claims discussed above.

Furthermore, the Examiner contends that since JFrame are JAVA frames, it would be obvious to apply these JAVA frames to a JAVA applet (*see* page 15 of the Examiner’s

Answer). Appellant respectfully maintains that the STS only discloses “JInternalFrame implements a frame object that can be placed inside a JDesktopPane object to emulate a native frame window.” That is, as in conventional techniques, the STS discloses using JInternalFrame for holding **JAVA documents**. Just because the frame is a JAVA frame and an applet is in JAVA does not mean that there is interoperability between the two and that one can be easily applied to another. In fact, **JInternalFrame are not intended for applet visibility**.

JInternalFrame lacks operations for holding an applet (*see e.g.*, page 9 of the specification).

In other words, there is no suggestion in the STS how to modify the JInternalFrame so that it can hold the applets. Furthermore, the Examiner has not set forth **any** motivation or reason why one of ordinary skill in the art would use JInternalFrame to display applets as opposed to an IFRAME or an HTML frame (*see e.g.*, pages 2-4 of the specification).

In other words, Appellant respectfully submits that the Examiner did not provide *any* motivation or reason for combining the STS with Banthia. Furthermore, it is respectfully submitted that one of ordinary skill in the art would not have been motivated (would not have any reason) to combine Banthia with STS without exercising impermissible hindsight.

For at least these additional exemplary reasons, claims 13, 27, and 41 are patentable over Banthia in view of STS.

REPLY BRIEF UNDER 37 C.F.R. § 41.41
U.S. Appln. No.: 09/747,063

CONCLUSION

For the above reasons as well as the reasons set forth in Appeal Brief, Appellant respectfully requests that the Board reverse the Examiner's rejections of all claims on Appeal. An early and favorable decision on the merits of this Appeal is respectfully requested.

Respectfully submitted,

/Nataliya Dvorson/_____
Nataliya Dvorson
Registration No. 56,616

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON DC SUGHRUE/142133

46159

CUSTOMER NUMBER

Date: May 5, 2008